



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,894	12/28/2004	Hinrich Wiese	62584(45107)	9848
21874 7590 06/05/2007 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			EXAMINER BERNSHTEYN, MICHAEL	
			ART UNIT 1713	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/519,894

Applicant(s)

WIESE ET AL.

Examiner

Michael Bernshteyn

Art Unit

1713

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

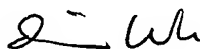
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-19.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.



DAVID W. WU

ADVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

Michael Bernshteyn  
Patent Examiner  
Art Unit 1713

Continuation of 11. It appears that the focus argument resides in the contention that there is no suggestion in Hiraoka that the adhesive compositions would be suitable for use in the method of Ederer. Applicants contend that one skilled in the art would not even look to Hiraoka in order to solve the object underlying the present invention, and one skilled in the art at the time the invention was made would not have considered cyanoacrylates as suitable building materials in combination with an aqueous bath fluid (pages 8-9, the bridging paragraph).

It is noted that Hiraoka discloses that 2-cyanoacrylate-based adhesive composition is excellent in storage stability and hardening properties of thick films and has a high hardening rate and remarkably improved surface hardening properties of the adhesive composition itself bulged from between adherends (col. 1, lines 7-13). In addition, the adhesive composition is excellent in thick-film hardening properties, and hence adhesion between the adherends having some clearance can also be achieved quickly. Simultaneously, the application of the adhesive composition to a potting medium and a coating agent is also sufficiently possible (col.5, line 64 through col. 6, line 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate cyanoacrylate, a mixture of cyanoacrylates or a mixture of one or more cyanoacrylate(s) with additional anionically polymerizable compounds, etc. and stabilizers as taught by Hiraoka in Ederer's rapid-phototyping production method because 2-cyanoacrylate-based adhesive composition can be obtained which is excellent in storage stability and hardening properties of thick films and which has a high hardening rate and remarkably improved surface hardening properties of the adhesive composition itself bulged from between adherends (US'554, col. 5, lines 36-41), and thus to arrive at the subject matter of instant claim 1 and dependent claims 2-5, 8-10 and 12. Furthermore, it is worth to mention that Applicants themselves considered the Hiraoka's reference as relevant to the application including it in IDS filed on 12/28/2004.

As to the arguments that a glycerine solution does not fulfill the requirements for a suitable bath fluid as outlined, for example, on page 4, lines 2 to 5 of the present application, according to which the disposal of the bath fluid by way of the regular canalization is possible without further action (pages 7-8, the bridging paragraph), it is noted that the rejection was made not under 35 U.S.C. 102(b), but under 35 U.S.C. 103(a) and Hiraoka's reference covers the deficiencies of Ederer's reference.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is further noted that "The motivation in the prior art to combine references does not have to be identical to that of the applicant to establish obviousness, i.e. it is not required for a finding of obviousness that motivation of the skilled artisan be the same as an applicant motivation", *In re Kamps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1312 (Fed. Cir. 1996) (holding there is sufficient motivation to combine teachings of prior art to achieve claimed invention where one reference specifically refers to the other).

Therefore, it is well settled that for a finding of obviousness under § 103 the prior art need not disclose the same motivation as disclosed by an applicant.

Regarding the arguments that one skilled in the art would not have considered it to be possible to make use of a 2-cyanoacrylate-based adhesive composition in combination with an aqueous solution in a method for directly printing elements and models (page 9, the last paragraph), it is worth to mention that Bredt disclose the usage of cyanoacrylates in a method of printing elements and models (WO 01/34371, page 33, claim 17).

As to the arguments that the building material recited in present claim 1 does not include the essential components of the adhesive composition described by Hiraoka (page 11, 1<sup>st</sup> paragraph), it is noted that Hiraoka clearly discloses an adhesive composition which comprises a 2-cyanoacrylate and at least one of compounds (a) and (b): (a) an addition reaction product of an epoxy group and a compound having a cyano group and a carboxylic acid group in its molecule, and (b) a compound having a cyano group and a carboxylic acid group in its molecule.

Therefore, the final rejection cannot be withdrawn and remains in force.